

**REMARKS**

Claims 1-37 are in the application. Claim 1 was amended to more clearly and distinctly claim the invention. Claim 20 was amended in accordance with the examiner's suggestion. No new matter was entered into the case by the amendment.

In the office action, claim 20 was rejected under 35 U.S.C. §112, first paragraph and second paragraphs. Claims 1-4, 6-7, 9, 11-12, 20-24, 26-28, and 30-35 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,177,153 to Lowe. Claims 1-3, 5-9, 11-12, 20-23, 25-28, and 30-35 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,720,615 to Izumi et al. Claim 10 was rejected under 35 U.S.C. §103(a) as being unpatentable over the '153 patent to Lowe. Claims 13, 15-16, and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over the '153 patent in view of U.S. Patent No. 5,344,579 to Ohtani et al. Claims 14, 17, and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over the '153 patent in view of U.S. Patent No. 6,225,266 to Watts et al. Claims 20-32 and 34 were rejected under 35 U.S.C. §103(a) as being unpatentable over the '153 patent in view of U.S. Patent No. 4,795,583 to Papay and U.S. Patent No. 6,844,301 to Field et al. Claim 36 was rejected under 35 U.S.C. §103(a) as being unpatentable over the '153 patent in view the '583 patent and the '301 patent and further in view of the '579 patent. Claim 37 was rejected under 35 U.S.C. §103(a) as being unpatentable over the '153 patent in view the '583 patent and the '301 patent and further in view of the '266 patent. The rejections are wholly untenable and should be withdrawn. Reconsideration and allowance of claims 1-37 are respectfully requested in view of the following remarks.

It is believed that the amendment to claim 20 overcomes the §112, second paragraph rejection of the claim. Reconsideration and withdrawal of the rejection are respectfully requested.

**A. The Rejection of Claim 20 for Non-enablement is Untenable.**

Claim 20 is directed to a method for improving the friction durability of a transmission fluid. A power transmission fluid, is understood by those skilled in the art as containing components necessary to provide the intended function. Page 14 of the specification identifies the components that may be contained in a power transmission

fluid, one of which is a friction modifier. Accordingly, since one of the elements of claim 20 is the preparation of a transmission fluid, the fluid, by definition contains friction modifiers.

Furthermore, the claim calls for improving the friction durability of the transmission fluid. Applicants have demonstrated that use of the claimed additive does in fact increase the friction durability as defined in the specification. Accordingly, regardless of the composition of the transmission fluid, use of the additive composition according to the method provides the claimed improvement. Applicants thus believe claim 20 is sufficiently enabled. Reconsideration and withdrawal of the rejection are believed in order and are respectfully requested.

**B. Claims 1-4, 6-7, 9, 11-12, 20-24, 26-28, and 30-35 Are Patentably Distinguished Over the Cited Reference.**

The invention relates to a power transmission fluid and to an additive combination that effectively improves the friction durability of the transmission fluid. The fluid contains a base oil, and a transmission fluid additive composition that includes a dispersant and a tertiary amine having one relatively short chain alkyl or alkenyl group, and two groups containing from about 8 to 100 carbon atoms. In other words, the tertiary amine contains at least two relatively long chain carbon-containing groups.

In the Office Action, the '153 patent to Lowe was cited as the primary reference in most of the rejections. The '153 patent teaches, suggest, and discloses lubricating oil compositions that impart oxidation properties to crankcase lubricants. There is no disclosure in the '153 patent relating to transmission fluids or methods to improve the friction durability of transmission fluids and thus the '153 patent fails to teach, suggest, or disclose a power transmission fluid additive as claimed in claims 1-19 or a method for improving friction durability of a transmission fluid as claimed in claims 20-37.

Additionally, the '153 patent prefers amines that contain only one relatively long chain hydrocarbon group or three relatively long chain hydrocarbon groups. There is nothing in the '153 patent that teaches, suggests, or discloses the desirability of use of a tertiary amine containing one short chain hydrocarbon group and two relatively long

chain hydrocarbon groups as provided in claims 1-37. In fact, all of the examples in the '153 patent either have only one relatively long chain hydrocarbon group, all short chain hydrocarbon groups, or all long chain hydrocarbon groups, and thus the '153 patent fails to teach suggest or disclose the claimed amine component of the claims. By contrast, applicants have discovered that only certain tertiary amines are suitable for improving the friction durability of a transmission fluid.

Finally, there is no teaching, suggestion, or disclosure in the '153 patent to provide a composition that contains a dispersant and the particular tertiary amine component in order to provide the advantages of the claimed invention. In fact, the '153 patent clearly suggests that the required components for a reduction in oxidation of a crankcase lubricant are a sulfide component and the amine component. While dispersants may be included, there is no specific teaching in the '153 patent that would lead one skilled in the art to select the combination of applicants' amine with a dispersant for any purpose much less for the purpose of improving the friction durability of a transmission fluid. Accordingly, the '153 patent is manifestly deficient in teaching, suggesting, or disclosing all of the elements of the claimed invention and the benefits therefor. Since the '153 patent fails to disclose all of the elements of the claimed invention, reconsideration and allowance of claims 1-4, 6-7, 9, 11-12, 20-24, 26-28, and 30-35 are believed in order and are respectfully requested.

**C. Claims 1-3, 5-9, 11-12, 20-23, 25-28, and 30-35 Are Patentably Distinguished Over the Cited Reference.**

In the rejection of claims 1-3, 5-9, 11-12, 20-23, 25-28, and 30-35, the '615 patent to Izumi et al. is cited. Like the '153 patent, the '615 patent fails to teach, suggest or disclose transmission fluids or methods to improve the friction durability of transmission fluids. The '615 patent is primarily directed to rust prevention in oils containing a small amount of water. Unlike the claimed invention, the required composition of the '615 patent is an acid or partial ester and an aliphatic tertiary amine. There is nothing in the '615 patent that suggests an additive composition devoid of the acid or partial ester or an additive composition that includes an ashless dispersant and the tertiary amine. The acid and amine composition described in the '615 patent is not the

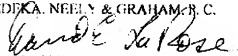
same or equivalent to the claimed additive composition containing an ashless dispersant and a particular tertiary amine containing at least two relatively long hydrocarbon groups. In fact, any tertiary amine, whether it contains one, two, or three relatively long hydrocarbon groups, appears to be suitable for the purposes of rust prevention. Whereas, applicants have discovered that only certain tertiary amines are suitable for improving the friction durability of a transmission fluid.

Additionally, there is no teaching, suggestion, or disclosure in the '615 patent to provide a composition that contains a dispersant and the particular tertiary amine component in order to provide the advantages of the claimed invention. In fact, the '615 patent clearly suggests that the required components for rust prevention are an acid or ester component and the amine component. While dispersants may be included, there is no specific teaching in the '615 patent that would lead one skilled in the art to select the combination of applicants' amine with a dispersant for any purpose much less for the purpose of improving the friction durability of a transmission fluid. Accordingly, the '615 patent is manifestly deficient in teaching, suggesting, or disclosing all of the elements of the claimed invention and the benefits therefor. Reconsideration and allowance of claims 1-3, 5-9, 11-12, 20-23, 25-28, and 30-35 are believed in order and are respectfully requested.

Respectfully submitted,

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